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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,189	11/13/2003	Lilip Lau	PARCR 65988	9393

7590 03/21/2005

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EXAMINER	
GILBERT, SAMUEL G	
ART UNIT	**PAPER NUMBER**
3736	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,189	LAU ET AL.	
	Examiner	Art Unit	
	Samuel G. Gilbert	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 54-66 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 54-66 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

The priority data in the first line of the specification should be updated, the status of all applications should be provided.

Information Disclosure Statement

The information disclosure statement filed 2/2/2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 55, 61, and 63-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language positively recites the combination of the human body and the cardiac harness and therefore is non-statutory because the human body is non-statutory. The examiner recommends using "adapted to" language.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 61 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The pressure range of 3 to 4 mmHg has not been previously set forth.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 54-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al (5,150,706).

Claim 54 – net –12- is an elastic cardiac harness, column 5 lines 52 and 53. Net –12- would have a different compliance for different size hearts and different size elements. Therefore the examiner is taking the compliance as claimed as an inherent feature of Cox et al, when a certain size net –12- is put on a certain size heart. Further, the compliance is directed to an intended use and method of using the device. If the claimed invention was on a shelf with net –12- of Cox et al the devices could be identical.

Claim 55 – is directed to an intended use of the harness and it is the examiner's position that the harness, net –12-, of Cox et al would be capable of generating the claimed compression source.

Claim 56 – the net –12- is made from an elastic material, column 5 lines 52/53. An elastic net would inherently have a deformed shape and recovered shape.

Claims 57-59 – the net -12- is capable of being compressed and delivered as claimed.

Claims 60 and 61 - the net –12- would have a net pattern for applying a compressive force. The compliance is capable of being expressed in terms of the pressure the harness applies to the heart. The range of compliance is a function of the heart size and the size of the net. The selection of a particular net for use on a

particular heart would provide the claimed compliance. Therefore the net –12- is capable of providing the claimed compliance.

Claim 62 – the net -12- is capable of being compressed and delivered as claimed.

Claims 63-66 – the claims are replete with functional language, the device of Cox et al. teaches a net –12- that is capable of performing.

Claims 54-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Alferness (5,702,343).

Claim 54 - Alferness teaches a heart jacket formed of an elastic material, column 3 line 10. An elastic heart jacket, figures 3-5, is inherently self-sizing over the elastic range of the jacket.

Claim 55 – is directed to an intended use of the harness and it is the examiner's position that the jacket would be capable of generating the claimed compression source.

Claim 56 – the jacket is made from an elastic material, column 3 line 10. An elastic net would inherently have a deformed shape and recovered shape.

Claims 57-59 – the jacket is capable of being compressed and delivered as claimed.

Claims 60 and 61 - the net –12- would have pattern for applying a compressive force. The compliance is capable of being expressed in terms of the pressure the harness applies to the heart. The range of compliance is a function of the heart size

and the size of the jacket. The selection of a particular jacket for use on a particular heart would provide the claimed compliance. Therefore the jacket is capable of providing the claimed compliance.

Claim 62 – the jacket is capable of being compressed and delivered as claimed.

Claims 63-66 – the claims are replete with functional language that the device of Alferness is capable of performing.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 54-60 and 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 18 of U.S. Patent No. 6,723,041. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious changes to the scope of the claims.

Claims 54-60 and 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,702,732. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious changes in the scope of the claims.

Claims 54-60 and 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,682,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious changes in the scope of the claims.

Claims 54-60 and 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,663,558. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious changes in the scope of the claims.

Claims 54-60 and 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,595,912. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the differences are obvious changes in the scope of the claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 6,174,279; 6,193,648; 6,293,906; and 6,645,139 teach related cardiac devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenberg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Samuel G. Gilbert
Primary Examiner
Art Unit 3736

sgg